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1654

3412/1A/US (PHA 4140.6)  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Mark G. Obukowicz et al. Art Unit 1654  
Serial No. 10/022,320  
Filed December 13, 2001  
Confirmation No. 4956  
For SELECTIVE COX-2 INHIBITION FROM NON-EDIBLE PLANT EXTRACTS  
Examiner Randall O. Winston

October 17, 2003

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop No Fee Amendment

COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Arlington, VA 22313-1450

SIR:

This letter is in response to the Office action dated October 3, 2003, in which an election of a Group of claims and an election of species for prosecution on the merits were requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. However, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added).

Claims 1-35 of Group I are generally directed to methods of inhibiting the activity of COX-2 in an organism by administration of an organic extract of a non-edible plant. Claims 36-42 of Group II are generally directed to the method of claim 1 wherein the method of obtaining the organic extract is specified. Claims 43-51 of Group III are generally directed to methods of treating

or preventing COX-2 mediated inflammation or an inflammation-associated disorder in an organism by administration of the composition obtained according to claim 36.

The claims of Group II relate to the claims of Group I in that Group II claims embody a method in which the extracts of Group I may be obtained. The claims of Group III relate to the claims of Groups I and II in that they embody a particular method in which the compositions obtained by the methods of Group II may be used in order to treat a particular disorder that may be treated by the inhibition of COX-2 according to the methods of Group I. Accordingly, Applicants note that the claims of Groups I, II, and III are related, and respectfully request rejoinder of Groups I, II, and III.

In addition, a search of any one of the Groups is co-extensive with a search in any one of the other Groups. A search of the art disclosing methods of inhibiting the activity of COX-2 in an organism by administration of an organic extract of a non-edible plant (Group I) will be co-extensive with a search of the art for methods of obtaining such extracts (Group II) and for methods of using such extracts for the treatment of disorders (Group III). Accordingly, the examination of the entire application may be made without serious burden.

Subject to the foregoing traverse, Applicants hereby elect the claims of Group I (claims 1-35) for further prosecution.

Furthermore, in response to the Examiner's request to elect a single disclosed species from Group I, Applicants elect the order Ranales. Claims 1, 2, 3, 22, 23, and 24 read on the elected species.

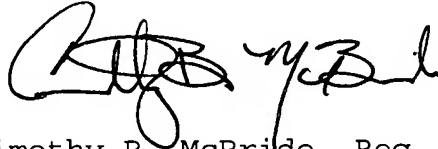
According to M.P.E.P. §809.02(c), an Examiner's action subsequent to an election of species should include a complete

action on the merits of all claims readable on the elected species, and according to M.P.E.P. §809.02(e), whenever a generic claim is found to be allowable in substance, action on the species claims shall thereupon be given as if the generic claim were allowed. Thus, if it is determined that the elected species is patentable, it is incumbent upon the Office to search additional species that fall within any allowable generic claims.

Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 19-1345.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy B. McBride', written over a horizontal line.

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